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09/924,325	08/08/2001	Peter John D. Wickham	3869/012	3579

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Gottlieb, Rackman & Reisman, P.C.
270 Madison Avenue
New York, NY 10016-0601

EXAMINER

WEISS JR, JOSEPH FRANCIS

ART UNIT PAPER NUMBER

3743

DATE MAILED: 02/02/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,325

Applicant(s)

WICKHAM, PETER JOHN D.

Examiner

Joseph F Weiss Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the weighting assignment member of claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the obstruction detector of claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the sampler of claim 3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the comparator of claim 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the signal generator of claim 6 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gruenke (US 5549106) in view of Rapoport (US 5803066).

Gruenke substantially discloses the instant application's claimed invention (see fig 18, the admittance embodiment) to include a gas source (18, fig 3) fully capable of selectively supplying gas to a user under pressure, a flow sensor 1802 for sensing flow and generating a flow signal indicative of gas flow, an obstruction detector (1800) for detecting an obstruction based upon a flow signal and generating an obstruction signal and a controller (20, fig 3) arranged to control the operation of said gas source and coupled to said flow sensor, receiving said signals and altering operation in response to said signals, but does not explicitly disclose a weight assigning member to assign weighting to different components of the flow signal. However, Rapoport disclose such (microprocessor 80, col. 7 line 50 to col.12 line 60, see specifically col. 10 lines 1-10 & col. 11 lines 12-26). The references are analogous since they are from the same field

of endeavor, the respiratory arts. At the time the instant application's invention was made, it would have been obvious to one of ordinary skill in the art to have taken the features of Rapoport and used them with the device of Gruenke. The suggestion/motivation for doing so would have been to render optimal/more accurate pressure support to resolve obstructive events. Therefore it would have been obvious to combine the references to obtain the instant application's claimed invention.

Furthermore, such a feature is old and well known in the art, and one of skill in the art would consider such to amount to a matter of mere obvious and routine choice of design, rather than constitute a patently distinct inventive step, barring a convincing showing of evidence to the contrary.

In regards to claim 2, the suggested device is fully capable of and does select sections of a breathing pattern, e.g. a single breath (See fig 19 of Gruenke).

In regards to claim 3, the suggested device's flow sensor inherently has a "sampler" to the extent applicant has a "sampler" (interpreted as the sensor taking a reading of flow and generating a signal indicative of the reading since no physical aliquot or "sample" of gas is occurring) and is further capable of assigning a weighing of the factors of the "sample's" signals.

In regards to claim 4, the suggested device's "samples" have amplitudes and the weighting establishable upon such.

In regards to claim 5, the suggested device's "samples" have time positions and the weighting establishable upon such.

In regards to claim 6, the rejection to claim 1 is herein incorporated by reference and furthermore has a signal generator (1812) that generates a signal based upon weighted values. (Note the generation of an admittance signal therefrom to microcontroller 802).

In regards to claim 7, the rejection to claim 1 is herein incorporated by reference and furthermore has a mask (14)

In regards to claim 8, the suggested device discloses a comparator (1812) to compare weighted average signals to a threshold and generating an obstruction signal (the admittance signal).

In regards to claim 9, the suggested device's flow sensor inherently has a "sampler" to the extent applicant has a "sampler" (interpreted as the sensor taking a reading of flow and generating a signal indicative of the reading since no physical aliquot or "sample" of gas is occurring) and is further capable of assigning a weighing of the factors of the "sample's" signals.

In regards to claim 10, the suggested device's "samples" have amplitudes and the weighting establishable upon such.

In regards to claims 11-13, the suggested device is fully capable of basing weighting upon amplitudes being above or below pre-determined values, correlating one weighing value with amplitudes below the value and another with amplitudes above the value and where one weighting factor is diminutive relative to the other.

In regards to claim 14, the suggested device's "samples" have time positions and the weighting establishable upon such.

In regards to claim 15- 17, the suggested device is fully capable of basing weighting upon amplitudes being above or below pre-determined values, correlating one weighing value with amplitudes below the value and another with amplitudes above the value and where one weighting factor is diminutive relative to the other.

In regards to claim 18, the suggested device is fully capable of and does select sections of a breathing pattern, e.g. a single breath (See fig 19 of Gruenke).

In regards to claim 19, the suggested device is fully capable of and does select sections of a breathing pattern, e.g. an inspiration period (See fig 19 of Gruenke).

In regards to claim 20, the suggested device is fully capable of and does select sections of a breathing pattern, e.g. a mid-portion of said inspiration period (See fig 19 of Gruenke).

In regards to method claims 21-40, one of ordinary skill in the art would appreciate that the method steps claimed in the instant application would naturally flow from the device disclosed in the prior art as noted above and therefore are rejected herein above with respect to claims 1-20.

Response to Arguments

1. Applicant's arguments filed 12 Nov 03 have been fully considered but they are not persuasive.

Applicant admits on the record in his arguments that the drawings do not disclose all the elements set forth in the claims. The CFR is a substantive rule, no exception to this substantive rule exists for what an artisan of ordinary skill would divine, let alone a skilled artisan. Applicant give no reasoned basis for his conclusions that a skilled artisan could divine the illustrated structure is actually something else, thus amounting to a bald assertion as to what a skilled artisan would be able to randomly speculate how the drawings illustrate the claimed invention. Thus the objection stands.

In regards to the objection to the specification applicant has resolved the issue by pointing to intrinsic evidence.

A prima facie case of obviousness has been established, the rejection sets forth all the elements of the positively claimed invention, motivation has been provided and a

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reasonable basis exists for one of ordinary skill to conclude that there is a reasonable expectation of success.

Generally please note:

2. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

3. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

4. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Note specifically:

ON the issue of weighing factors, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). If applicant's species of weighing factors are different and patently distinct from the genus represented in the prior art applicant needs to positively and specifically claim this species, and not just

claim the genus and then speculate how one of skill in the art (the wrong legal standard, which is one of ordinary skill) would read limitations into the claims from the written description or if applicant is trying to argue reading the claims only in light of the written description, then in addition to the wrong legal standard, he has not presented any evidence to support this argument, just speculation.

This analysis address all of applicant's arguments for all claims by dint of the fact that all of applicant's arguments to the claims is predicated on this erroneous legal argument that impermissibly inserts written description limitations into the claims and uses the wrong legal standard. Hence all of applicant's arguments have been addressed.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

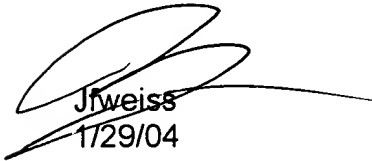
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

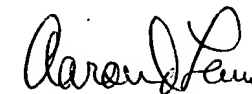
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F Weiss Jr. whose telephone number is 703-305-0323. The examiner can normally be reached on M-F, 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 703-308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.


Jfweiss
1/29/04


Aaron J. Lewis
Primary Examiner